

REMARKS

I. Introduction

Claims 7, 8 and 11-13 are currently pending in the present application. Claims 7, 8 and 11-13 have been rejected by the Office Action. In view of the following remarks, it is respectfully submitted that the pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 7, 8 and 13 under 35 U.S.C. § 102(e)

Claims 7, 8, and 13 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,700,823 (the "Rahman" reference). Applicants respectfully submit that claims 7 and 8 are allowable over the "Rahman" reference for the following reasons.

To anticipate a claim under § 102(e), a single prior art reference must identically disclose each and every claim element. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claim invention, arranged exactly as in the claim. Lindeman, 703 F.2d 1458 (Emphasis added). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

The "Rahman" reference does not identically disclose, or even suggest, the feature that "at least one switching arrangement is configured to *selectively individually separate* each of the first and second terminating resistors from the two-wire line," as recited in claim 7; instead, the "Rahman" reference shows a switching arrangement that simultaneously and non-individually activates the resistors. "Switches 112 are used to connect or disconnect

resistors 108 and 110 across lines 106.” (Rahman reference, column 3, lines 5 to 6). In fact, both switches have been given the same number in each embodiment of the “Rahman” reference, indicating **identical** and **not individual** functionality. (See, e.g., Figures 1 to 3). Nowhere in the reference is it disclosed, or even suggested, to **selectively individually separate** each of the first and second terminating resistors, as recited in claim 7.

Therefore, for at least the foregoing reasons, claim 7 and its dependent claims 8 and 13 are not anticipated by the “Rahman” reference, and it is respectfully requested that this anticipation rejection be withdrawn.

III. Rejection of Claim 11 under 35 U.S.C. §103(a)

Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over the “Rahman” reference in view of U.S. Patent 6,853,213 (the “Funaba” reference). Applicants respectfully submit that the combination of the “Rahman” and “Funaba” references does not render obvious claim 11 for the following reasons.

In rejecting a claim under 35 U.S.C. §103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091 (Fed. Cir. 1986). Third, the prior art references must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). To the extent that the Examiner may be relying on the doctrine of inherent disclosure to support the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Claim 11 ultimately depends on claim 7. As noted above, the “Rahman” reference

fails to anticipate claim 7. Furthermore, the "Funaba" reference fails to remedy the deficiencies of the "Rahman" reference in regards to the rejection of claim 7. Therefore, dependent claim 11 is allowable over the combination of the "Rahman" and "Funaba" references.

IV. Rejection of Claim 12 under 35 U.S.C. § 103(a)

Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the "Rahman" reference in view of U.S. Patent 6,324,044 (the "Teggatz" reference). Applicants respectfully submit that this rejection should be withdrawn for at least the following reasons.

Claim 12 ultimately depends on claim 7. As noted above, the "Rahman" reference clearly fails to anticipate claim 7, as presented. Furthermore, the "Teggatz" reference fails to remedy the deficiencies of the "Rahman" reference in regards to the rejection of claim 7. Therefore, dependent claim 12 is allowable over the combination of the "Rahman" and "Teggatz" references.

V. CONCLUSION

Applicants respectfully submit that all pending claims of the present application are now in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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